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EXAMINER

DETWILER, BRIAN J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/494,801
Filing Date: January 31, 2000
Appellant(s): GAUDETTE, ARTHUR L.

Rhonda L. Sheldon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 August 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant has not provided reasons for separate patentability under the "Argument" section as required by 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,142,619

Webster, III

8-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-11, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,366,933 (Ball et al) and U.S. Patent No. 5,142,619 (Webster, III).

Referring to claims 1, 2, 4, 6, 8, 9, 11, 13, 15, and 20, Ball discloses in column 1: lines 50-57 and further illustrates in Figures 11 and 12 an invention for comparing cached and current versions of an Internet web page. Ball's invention inherently operates on processor-based systems with storage media for storing program instructions. In Figure 12, Ball discloses a button labeled "DIFF" that, upon actuation, causes the differences between the cached and current versions of the Internet web page to be displayed on the screen. Furthermore, Ball discloses in column 20: lines 26-53, that the current version of the web page can be provided directly from a web server. Ball, however, fails to disclose a navigation bar with a subtract button image. Webster, though, discloses in column 4: lines 5-32 an invention for comparing two files wherein a compare button [66] is implemented in an editing program's action bar [62]. The action bar is interpreted to correspond to the claimed navigation bar since it is the main toolbar from which users of Webster's invention can operate the application. The compare button [66], upon actuation, causes only the differences between the two files to be displayed on the screen in window W3. As illustrated in Figure 4, compare button [66] uses a textual label for identification. Although the compare button [66] does not contain a subtract image, the button behaves in a similar manner to the button in the claimed invention. At the time the invention was made, it certainly would have been obvious to a person of ordinary skill in the art to modify

Art Unit: 2173

the compare button [66] by changing the label to an image of a subtraction sign. Applicant has not disclosed that the subtract image provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a textual label because the button's behavior would remain the same. Therefore, it would have been obvious to one of ordinary skill in the art to modify Ball's invention to use a subtract image instead of a textual label. Finally, it further would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the DIFF link into Ball's navigation bar as a subtract button as suggested by Webster. This would have been advantageous because the placement of tools and other extraneous features into the navigation bar provides a significant increase in convenience and usability. Users can subsequently have access to plurality of features from a single centralized location. One of ordinary skill in the art would easily have recognized this and been motivated to make the corresponding changes.

Referring to claims 3 and 10, Ball discloses in column 19: lines 1-10, a method for showing the differences between two Internet web pages, wherein only the differences are displayed on the screen. Said method corresponds to the claimed limitation of "blanking the common material".

Referring to claims 7, 14, and 19, Ball illustrates in Figure 11 that differences are presented to the user as an HTML file in a web browser. Assuming that a user is viewing the current version of a web page before requesting that the differences be displayed (a requirement of appellant's invention), he or she could toggle between displaying the differenced version and

Art Unit: 2173

the current version simply by using the "back" and "forward" functions that are inherent to web browsers.

Referring to claims 16-18, Ball illustrates in Figure 12 a button image (labeled DIFF), that upon actuation, causes a cached version and a current version of an Internet web page to be differenced and the results displayed on the screen, as shown in Figure 11.

(11) Response to Argument

Regarding claims 1 and 8, appellant first asserts that Ball fails to disclose differencing a cached version and a current version of an Internet web page where the current version is provided directly by a web server. Appellant continues by listing the numerous steps in Ball's invention that must be taken in order for two versions of a web page to be differenced. Appellant insists that the current version of the web page must be copied to Ball's "External Service" before it is compared to a cached version. Appellant is absolutely correct in this assertion, but fails to recognize that the copying step anticipates appellant's invention as claimed. The External Service is essentially Ball's invention, and thus by merely receiving a copy of said current version from a web server, the External Service is enabled to "difference a cached version and a current version of an Internet web page, said current version being provided directly by a web server," (claims 1 and 8). As further supported by Figure 1 and column 3: lines 44-67, the External Service is linked directly to the Repository (World Wide Web). The additional steps indicated by Appellant, which occur between receiving the current version and differencing it with a cached version, are irrelevant since the current version of the web page MUST at some point be provided directly to the External Service by a web server located in the Repository. Furthermore, it should be immediately recognized that the claims fail to define a

Art Unit: 2173

timeframe in which any of steps are to occur. The claims merely enable a processor-based system to perform numerous functions at arbitrary times.

Appellant next asserts that Webster and Ball fail to disclose providing a graphical user interface of a navigation bar with a subtract button image. It should first be recognized that in claims 1 and 8, Appellant's navigation bar and subtract button lack specific functionality. Appellant only claims that these objects be provided. As can be seen in Figures 3A and 4 respectively, Ball and Webster both disclose navigation bars. Webster's navigation bar [62] even includes a compare button [64], which upon actuation behaves similarly to how Appellant's subtract button might perform if such a behavior were claimed. While Webster's compare button doesn't include a subtract image, appellant has failed to disclose that such an adornment provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Appellant's subtract button to perform equally well with a textual label, "COMPARE" for instance, because the button's behavior would remain the same. Accordingly, it would appear that one would have been motivated to use a subtract image as merely a matter of personal preference only. Any other motivation conjectured by the examiner would further limit Appellant's subtract button beyond that which is claimed.

Appellant still further asserts that there is no suggestion, motivation, or teaching to modify Ball with the teachings of Webster. It is again noted that in claims 1 and 8, Appellant claims the providing of a navigation bar and a subtract button, but fails to disclose the purpose of these objects. As mentioned above, Ball already discloses a navigation bar in Figure 3A. The navigation bar includes a plurality of selectable menus that are common to browser interfaces.

Art Unit: 2173

Ball also discloses a DIFF link in Figure 3A, which upon selection causes two versions of a web page to be differenced. Ball, though, fails to disclose that the DIFF link is implemented in the navigation bar. Webster, however, discloses in Figure 4 a navigation bar [62] comprising a compare button [64] that similarly causes two files to be differenced. Webster thus discloses one example wherein a compare/DIFF/subtract button is implemented in a navigation bar. As for motivation to apply such a teaching to the invention of Ball, the Federal Circuit Court has indicated that “there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In the instant case, motivation comes from the knowledge of persons of ordinary skill in the art. One of ordinary skill in the art would have recognized that Webster’s compare button is advantageously placed in the navigation bar as a matter of convenience and usability. In fact, the placement of tools in the navigation bar of an Internet browser can be considered a fundamental rule in software development. The examiner thus maintains that one of ordinary skill in the art would have had the motivation and teachings to integrate the DIFF link into Ball’s navigation bar.

Regarding claim 15, appellant presents much of the same argument applied to claims 1 and 8 above. Claim 15 is nearly identical to claims 1 and 8, except that it includes the word “immediately” instead of “directly” to distinguish when the current version of a web page is received from a web server. As with claims 1 and 8 above, it should be immediately realized that the claim fails to define a timeframe in which any of steps are to occur. The claims merely enable a processor-based system to perform numerous functions at arbitrary times. In the

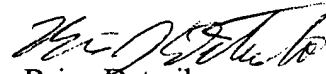
Art Unit: 2173

limitation, "said most current version being immediately received from a web server," the term "immediately" carries little significance since there is no indication of what the receipt of the most current version is immediately occurring after. It is then certainly reasonable to conclude that when the current version is copied to the External Service in Ball's invention, this step occurs immediately. Appellant's remaining arguments regarding claim 15 have been fully addressed above.

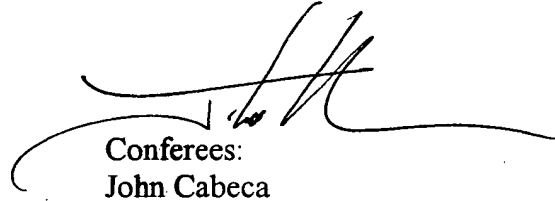
Regarding claims 7, 14, and 19, appellant asserts that Ball fails to disclose enabling a system to toggle between indicating the difference between cached and current versions and indicating the current version. As mentioned above, "back" and "forward" functionality is inherent to navigating the Internet with a web browser. Appellant's argument that the examiner failed to take Official Notice of this teaching is moot since the examiner is not relying on an Officially Noticed teaching, but rather an inherent fact. Appellant further argues that this evidence does not even anticipate the claimed invention. It should be realized that appellant only claims enabling a user to toggle between indicating the difference between cached and current versions and indicating the current version. This limitation should not be interpreted to mean a single button or control that upon selection executes a toggling behavior. Instead it is the mere enabling of a user to perform the toggling in any plausible manner. Said inherent "back" and "forward" functionality does just that. It enables a user to toggle between displaying two web pages. In the instant case, the two web pages are one that indicates the difference between the cached and current versions and the current version itself.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Brian Detwiler
Patent Examiner
September 17, 2003



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